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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/719,101

Filing Date: February 23, 2001

Appellant(s): ROLLAT-CORVOL ET AL.

Mark D. Sweet
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed April 10, 2008 appealing from the Office action
mailed March 28, 2007.

(1) (1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is essentially correct. Note, the Obvious Double Patenting rejections over US Patent 6,346,324 is herein withdrawn in view of the terminal disclaimer filed July 27, 2007.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

EP 0 551 749 A2 Lee et al. 21 July 1993.

WO 95/18191 A1 Miller et al. 6 July 1995

(9) Grounds of Rejection

Claim Rejections 35 U.S.C. 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 38-43, 45-50, 69, 78,79,83, 84, 88-106 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to composition comprising polymers, which are solely defined by physical properties “tacky” ; Tg, F_{max}, or E_{s(M/V)}. etc. However, the specification provides no written description as to what the structural characteristics of a polymer would be required to meet all the functional limitations herein. In view of the fact of lacking working examples, guidance, and direction, one of ordinary skill in the art would have reasonable doubt that applicants, at the time the application was filed, had actual possession of such polymers other than the particular commercially available polymers herein employed.

Claim Rejections 35 U.S.C. 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 38-58, 60, 69, 78, 79, 83, 84, 88-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al (EP 0551,749, of record), in view of Miller et al. (WO 95/18191, IDS).

Lee teaches a hair treatment composition comprising a water-insoluble, water-dispersible polymeric resin and a water-soluble amphoteric polymer (see abstract, page 3, lines 6-50; and pages 7-8, claims 1-8). Most preferred water-insoluble polymeric resin includes polyesters functionalized with a sulpho group such as Eastman AQ polymers (see pages 3, lines 15-20). Acrylate-based copolymers to be used advantageously as water-soluble amphoteric polymer of the composition, such as octaacrylamide/acrylates/butylaminoethyl methacrylate copolymer in hair treating composition (see page 3, lines 30-37). The water soluble amphoteric polymer provides a very substantial hold, and provide aiding in removing the water-insoluble resin in a hair composition from the hair upon shampooing (pages 3, lines 5-14).

5. Lee does not teach expressly the employment of branched sulfonic polyester herein with Tg less than 20 °C.

6. However, Miller et al. teaches the improved branched sulfonic polyester with lowed Tg. The low Tg provide advantage that the composition will not be brittle at low temperature, thus maintain its property. (see particularly, pages 16-18).

Therefore, it would have been *prima facie* obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin.

A person of ordinary skill in the art would have been motivated to modify Lee's composition by using the branched sulfonic polyester as the water-dispersible resin because the branched sulfonic polyester will not become brittle or lost its property at low temperature.

(10) Response to Argument

Rejection under 35 U.S.C. 112, first paragraph.

Appellants argue that limitations define physical properties as herein recited are not functional limitations. The arguments are not probative as to the rejections on the record. Property is a functional description of a subject. Further, the fact is that the application fails to link the property with the chemical structure of the polymer. One of ordinary skill in the art can not envision any polymer having such properties other than the commercial product employed herein. As stated in the rejection, a screen method for finding a compound is not a proper written description for the compound. See, *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 920-23, 69 USPQ2d 1886, 1894-95 (Fed. Cir. 2004).

Appellants further contend that the specification provide reasonable description for the polymer claimed, citing page 7-12. It is noted that page 7-12 merely disclose examples of two preferred embodiments, i.e. branched euphonic polyesters, and (math)acrylic ester polymers, two structurally distinct polymers. The application provides no written description as to the structure-function relationship. Therefore, the application fails to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of any other polymers having the physical properties herein defined.

Rejection under 35 U.S.C. 103

7. In response to appellant's argument that Miller is directed to hot-melt adhesive and therefore is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Miller reference is reasonably pertinent to the particular problem with which the applicants were concerned. Particularly, Miller teaches the tacky polymer herein. Miller particularly teaches the polymer with lower Tg have many advantage over higher Tg polymer, particularly, the polymer will not be brittle (soft) at low temperature (10 °C). Further, it is noted that the polymer disclosed by Miller (Eastman QA 1355) is structurally similar to those employed by Lee et al. (Eastman AQ 55), but with a low Tg, or softer.

In response to appellant's arguments that Lee preferred Tg of the polymer be in the range of 50oC to 70 oC, it is noted that disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971).

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, and motivation are found both in the references and in the knowledge generally available to one of ordinary skill in the art. Particularly, Lee teaches hair composition with a combination of polyesters functionalized with a sulfo group such as Eastman AQ polymers (see pages 3, lines 15-20) and acrylate-based copolymers such as octylacrylamide/acrylates/butylaminoethyl methacrylate copolymer, Miller et al. teaches the improved branched sulfonic polyester with lowered Tg. The low Tg provides an advantage that the composition will not be brittle at low temperature, thus maintaining its property. As to the particular physical properties of the polymer recited herein, note “Products of identical chemical composition can not have mutually exclusive properties.” A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Further, it is well settled that “As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reason contemplated by the inventor.” *In re Beattie* 947 F.2d 1312 (Fed. Cir. 1992).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Shengjun Wang

/Shengjun Wang/

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